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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,145	11/30/2001	Brandon R. Mackay	14591.11	4556

22913 7590 10/21/2004

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EXAMINER

BRITTAIN, JAMES R

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,145

Applicant(s)

MACKAY ET AL.

Examiner

James R. Brittain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7, 10-20, 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 8 and 21 is/are rejected.
- 7) ☒ Claim(s) 24-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Weil (US 2704961).

Weil (figures 7-12) teaches eyeglass retainers comprising a cord 13' having a first end and a second end and first and second connectors 14' coupled to the first end and second ends of the cord 13' wherein the connector has a hollow portion 15 and an opening comprised of two distinct portions, the first portion being the hole 22 that has a constant diameter and the second portion being the hole 23 that widens toward the hollow portion 15 so as to have a conical configuration different from the first portion 22, in the tubular wall that are inherently capable of being secured to the earpiece and the temple of eyeglasses if so desired. This construction of an opening having two adjacent distinct components is consistent with applicant's claim construction. The first 22 and second 23 portions are different through their different configuration. Weil states in that "The construction is such that tube 14 is engaged over a bulky

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temple 12 the same as described above.” (col. 2, lines 56-57) and this is described by “Each gripper member 14 is a molded tube of rubber or like material having one end of its bore 15 open to receive the end of one of the temples 12. [¶]The bore 15 preferably has a slightly smaller cross section area than the temple 12 so that the latter will fit tightly therein. Further, the bore 15 is made long enough to receive a sufficient length of the temple 12 to ensure enough frictional engagement to prevent accidental disengagement of said temple therefrom.” (col. 1, line 76 through col. 2, line 4). Further, the use of the opening having a first portion 22 and an adjacent second portion 23 is described by “However, by means of the holes 22 and 23 the same is also engageable by the temples 17 and 18” (col. 2, lines 56-59) and “The hole 23, it will be seen tightly grips the temple 18 and the same is securely fastened to the tube 14” (col. 2, lines 63-65). The connectors are comprised of rubber that is elastic and would be inherently capable of being inserted over the earpiece of less curvature than that of the shown glasses so as to be placed on the temple of the eyeglasses. Since the connectors are made of rubber the openings in the tubular wall are also expandable so as to grip as indicated above. In regard to claim 21, the application of the teachings of Weil are applied in the same manner and the first 22 and second 23 portions of the opening are of different configuration.

Allowable Subject Matter

Claims 1-7, 10-20, 22 and 23 are allowed.

Claims 24-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed July 22, 2004 have been fully considered but they are not persuasive.

Applicant argues that the retainer of Weil doesn't have an opening with a plurality of portions, each being different or having a different configuration. This is not persuasive because as pointed out above, Weil has a hollow portion 15 and an opening comprised of two distinct portions, the first portion being the hole 22 that has a constant diameter and the second portion being the hole 23 that widens toward the hollow portion 15 so as to have a conical configuration different from the first portion 22, in the tubular wall that are inherently capable of being secured to the earpiece and the temple of eyeglasses if so desired. This construction of an opening having two adjacent distinct components is consistent with applicant's claim construction. The first 22 and second 23 portions are different through their different configuration. Applicant has shown by repeated claim construction as found in comparing claims 10 and 12, claims 14 and 15, or claims 17 and 19 that the opening in each of the independent claims 10, 14 or 17 only requires the hole to be adjacent to the slit, in other words the two different configurations can be separate and distinct from each other, and it is only in the respective dependent claim 12, 15 or 19 that the independent claims are further limited in scope so that hole is in communication with the slit. Weil is being applied in this manner to claims 8 and 21, wherein opening is being interpreted to permit separate and distinct portions 22, 23 that have different configurations.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is (703) 308-2222. The examiner can normally be reached on M-F 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James R. Brittain
Primary Examiner
Art Unit 3677

JRB